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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			RHEE, JANE J	
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1 RECORD OF ORAL HEARING

2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
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10 *Ex parte* VOLKER HENNINGE, CHRISTIAN HYING and  
11 GERHARD HORPEL  
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14 Appeal No. 2009-011170  
15 Application No. 10/524,143  
16 Technology Center 1700  
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19 Oral Hearing Held: January 21, 2010  
20  
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22 Before BRADLEY R. GARRIS, CHARLES F. WARREN, and  
23 TERRY J. OWENS, *Administrative Patent Judges*.  
24

25 APPEARANCES:

26  
27 ON BEHALF OF THE APPELLANT:

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1 THE CLERK: Good morning. Calendar number 52, appeal number  
2 2009-011170 and calendar number 53, 2009-011171.

3 Mr. Harris Pitlick, counsel for appellant.

4 JUDGE GARRIS: Good morning, Mr. Pitlick. Sir, would you please give a  
5 business card to our reporter.

6 As you know, Mr. Pitlick, you have 20 minutes. Please begin.

7 MR. PITLICK: Okay. I assume we're doing to 11170 first?

8 JUDGE GARRIS: Yes.

9 MR. PITLICK: All right. We have a number of rejections here. Two are  
10 under 35 USC section 103 and one rejection over obviousness type double  
11 patenting.

12 The invention here is a separator. In the broadest claim it's intended for use  
13 in a lithium battery. And it's characterized by having a porous, inorganic  
14 coating over a nonwoven which is made up of an unwoven  
15 nonelectroconductive polymer fibers.

16 The nonwoven has a thickness of less than 30 microns; it's got a porosity of  
17 more than 50 percent and pore radius of -- a pore radius distribution in  
18 which at least 50 percent of the pores have a pore radius of 75 to  
19 150 microns.

20 Now, the main reference which the Examiner relies on is Yen. And as we've  
21 pointed out in Yen, Yen has a coating on their fibers which is referred to as a  
22 high solubility parameter polymer. So right away Yen doesn't disclose an  
23 inorganic coating. As we pointed out, there is no prima facie case because  
24 we're not even in the ballpark, so to speak.

1 The Examiner says that Yen is inorganic because you could have actually an  
2 optional filler, but it's still basically a polymeric and certainly by no stretch  
3 of the imagination can an inorganic coating be construed as the one that Yen  
4 discloses.

5 The Examiner relies on Omae, et al., for a disclosure of a pore diameter.

6 Omae has a substantially different type of, let's call it a base, a base for their  
7 separator, which is a fairly complicated sea island type composite fiber.

8 There are quite a few limitations in Omae about that particular fiber. But  
9 they also say it has a maximum pore diameter ranging between 25 and  
10 150 microns. So the Examiner holds that it would have been obvious to, in  
11 effect, make the separator of Yen with this maximum pore diameter range.

12 As we pointed out in the Brief, certainly without -- our present disclosure as  
13 a guide, one skilled in the art would not have combined them, but even if  
14 they were combined, the result would not be the presently claimed invention.  
15 So I think our argument is pretty straightforward. I just want to touch on the  
16 obviousness type double patenting rejection.

17 JUDGE WARREN: Counselor, can you characterize an inorganic coating as  
18 one that contains only inorganic particles? Do you have anything in your  
19 spec which limits inorganic coating to just inorganic material?

20 MR. PITLICK: Well, other than the fact that -- as I recall, we don't have  
21 disclosure that says you cannot have organic materials in there. On the other  
22 hand, we don't have any disclosure of any organic materials in there. And  
23 it's certainly clear from the specification as a whole that our coating is  
24 strictly inorganic.

1 Obviously, as you well know, you never can predict what the prior art might  
2 be out there. So you have to think of all the possibilities of, well, you are  
3 going to think that maybe the Examiner is going to come up with a coating  
4 that's organic and so you have to think ahead, well, I have to say that I don't  
5 have any organic materials in there.

6 But again, when you look at the disclosure as a whole, it's clear that there are  
7 no organic materials in our coating. And inorganic should be construed as it  
8 normally would be construed. When it says inorganic, it's inorganic and has  
9 no organic materials in there. Certainly no significant organic materials.

10 By reference it's by and large an organic polymer with, as I say, optional  
11 fillers not even required. So I think that answers your question, Judge  
12 Warren.

13 As far as the obviousness type double patenting rejection, again, the  
14 Examiner relies on the co-pending application in Omae, and we've already  
15 talked about the deficiencies in Omae.

16 I just want to point out that that co-pending application, there is a foreign  
17 equivalent which actually is mentioned in the specification and we talk  
18 about, you know, its various disadvantages.

19 So again, one skilled in the art would not combine Omae with any of the  
20 claims of that co-pending application. And I might also add that I'm not sure  
21 what maximum pore diameter -- I mean, maximum pore diameter is not the  
22 same thing as pore radius or at least 50 percent of the pores having a pore  
23 radius within a certain range.

24 But we really don't have to reach that question because, as I say, even if the  
25 pore diameter or the maximum or the pore radius, et cetera, were somehow

1 related, again, you still wouldn't wind up with our invention.

2 JUDGE GARRIS: Any other questions? No further questions.

3 Whereupon, the proceedings at 9:11 a.m., were concluded.

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